

REMARKS

Drawings

In deference to the last Office Action the Applicants have added new Figures 9-11 showing a typical pine cone with which the collection tool is operative and the entry of such pine cone into the collection tool. It is to be understood, however, the pine cone *per se* constitutes no part of the instant invention and it is only the thing upon which the invention operates. By reason of this thinking Applicants make the drawing amendment only as a matter of comity and not by way of agreement. Applicants have no quarrel with the Examiner's statement that the drawings must show every feature of the invention specified in the Claims, but the pine cone is not a feature of "the invention" nor specified as such in the Claims. For that reason it was not originally illustrated. It is to be noted in the references cited by the Examiner that Blyth does not illustrate the "grounded nuts" which his tool is designed to pick up.

The entry structure shown in Figure 11 was made from the CAD File of the entry structure of Figure 6 with only appropriate modifications to show passage of the pine cone of Figure 10 therethrough. Thus no new matter has been added by the new drawings, except for the pine cone which the Examiner requested.

Claim Objections

In deference to the Examiner's objections all of Claims 1,3,4,6,7 and 11 have been modified, hopefully to overcome the objections thereto. Applicants believe that the punctuation at the end of Line 12 was correct as originally stated. The normal rule of American grammar is that no punctuation mark can be of a higher order within a sentence or clause than any punctuation mark that precedes it, except at the end. In this instance there is a semi-colon at the end of Line 7 and therefore the punctuation at the end of Line 12 could not be a colon which is of higher rank.

The primary problem with Claim 1, Line 17 is the extraneous word “of” which has been removed as well as the indefinite article. In Claim 3, Line 4 the words “downwardly” and “inwardly” would appear to have the same meaning and selection would be merely a matter of choice.

The objection to Claim 7, Line 3 presents a traditional problem between the PTO vernacular and the commonly used English language. Applicants are aware that the PTO traditionally treats possessive pronouns as being ambiguous, but by using the indefinite article “a” the phraseology now tends to indicate that there is more than one “radially outer portion” which is not the case.

The matters concerning “Claim Objections” cannot help but bring to mind a change Notice to the Third Edition of the MPEP by Assistant Commissioner Wall made on July 23, 1968 which seems to have disappeared from later editions of the MPEP for some unknown reason. As a matter of interest a copy of that Change Notice is appended hereto.

Claim Rejections - 35 USC §112

Claim 7, Line 4 presumptively was objected to for use of the definite article “the” or possibly because the word “portions” was plural. Both of these items have been modified to attempt to overcome the objection. The Applicants are aware that traditionally the PTO vernacular has treated the word “the” apparently as a reflective pronounial adjective that requires an antecedent basis, but by making the change to the indefinite article the same problem as previously pointed out arises. The phraseology now would tend to indicate that there is more than one “radially inner portion” which is not correct. Claim 11, Lines 32 and 34 appear to present the same problem and have been treated in the same fashion as Claim 7, Line 4.

Claim Rejections - 35 USC §102

Claims 1,2,6-9 were rejected as being anticipated by Edwards. The Edwards pick-

up device for nuts was known and tested by the Applicants in doing research upon the instant invention but the Edwards device was found to be ineffective in picking up pine cones as the pine cones firstly would become entangled and not pass through the multi-layers of the “plurality of resilient pieces” and secondly a pine cone would not move into the chamber above the “plurality of resilient pieces” by moving or forcing the tool downwardly over the pine cone. It is to be noted in the Edwards device that a nut when picked up with that device is not move directly into the containment chamber above the “resilient pieces” as in the instant invention. Rather the nut is moved through the various layers of “resilient pieces” by additional nuts that are later picked up. The Edwards device was found not to be operative for collecting pine cones as the cones become entrapped in the layers of “resilient pieces: and would not be moved therethrough by subsequent pine cones because the pine cones had a rough unconsolidated surface rather than the smoother hard surface of nuts.

In Claim 1 and dependent Claims 2,6-10 it was attempted to point out this distinction by claiming only “at least two * * triangular-like fingers”(14-18) to “allow passage of pine cones therethrough” upon deformation of the fingers responsive to force exerted by the pine cone. To remove any ambiguity in this regard Claim 1, Line 19 has been modified to require the fingers to be carried by the entry structure in coplanar relationship (one layer) and in Lines 22-25 to require the pine cone to pass through the fingers by reason of force exerted on the fingers by the single pine cone in passing through the entry structure (rather than by a second pine cone). The other independent Claim 11 has been modified to include the same distinctions.

As to Claim 8, after extensive research the inventors conducted, it was found that the effective and efficient operation of the instant collection tool was quite sensitive to the resilient deformability and retentent memory of the plastic from which the fingers are formed. The plastics limited in Claim 8 all are more resiliently deformable and have somewhat more retentent memory than the polyvinyl chloride taught by Edwards.

Polyvinyl chlorides have been found to be less deformable and have a slower acting memory to not be well and efficiently operable in the instant invention, if in fact they are operable at all.

The Examiner's reference to Column 8, Lines 3-7 in Edwards does not appear to be relevant as that paragraph is merely a generic statement seeking to encompass equivalents, but there is no showing what the equivalents are or how or why they might be operative in the instant invention.

As to Claim 6 it does not appear that any of Edwards "fingers" are angulated in their normal relaxed state or that Edwards is at all concerned with this problem. The drawing of Figure 4 merely shows fingers 41 in a stressed condition caused by the passage of nuts therebetween and does not show angulation in an unstressed state as in the instant invention.

As to Claim 7 it does not appear that the space between the two legs of the "U" shaped element creating two "fingers" is in fact a slot with a radially outer bulbous enlargement. The space shown in the drawings is larger at its radially inner portion than it is in its radially outer portion as seen in Figure 3.

As far as Claims 2 claiming cylindrical configuration and Claim 9 claiming threaded engagement of the body and entry structure go, those elements in general obviously are well known aside from Edwards and the patentability of the instant Claims 2 and 9 would rise or fall with the destiny of their parent independent Claim 1. These Claims 2 and 9 only present additional limitations upon the structure of Claim 1.

Claim Rejections - 35 USC §103

Claims 3 and 4 were rejected over Edwards as a principal reference and Layton as a teaching reference. Layton merely shows two opposed vertically oriented "U" shaped handles on a slide hammer that constitutes part of a tool. Admittedly such handles are and were known *per se* long before Layton. Claims 3 and 4, however, are dependent claims

that further limit the invention of Claim 1, so it would appear that the fate of Claims 3 and 4 will rise or fall with that of Claim 1. It is to be noted, however, in regard to Layton that his handles are not used to move a tool body as are the handles in the instant invention, but rather the Layton handles only move a slide hammer which itself is an element of a more complex tool which those handles do not directly move.

Claim 5 is rejected by the Examiner with Edwards a principal reference and Crow as a teaching reference. Crow shows another nut harvester that has a single layer of spaced parallel springs extending across an entry orifice. The Crow reference apparently was cited to show some type of entry member that is in formed with a single layer of coplanar elements. The reference, however, is not concerned with picking up pine cones and would not be operative in so doing as pine cones would not enter such a structure that has no medial void to allow their passage and additionally would become entangled between the springs because of their unconsolidated surface. Additionally, there is nothing in either Edwards or Crow that would indicate how or why either reference should be combined with the other to accomplish anything, let alone the instant invention.

As to Claim 10 it is indicated that Edwards teaches his device may be of any desired dimension. It does not appear that Column 8, Lines 3-7 do this as this language is only a generic statement seeking to invoke the Doctrine of Equivalents (which is a litigation doctrine rather than a prosecution one) and sets forth nothing relating to dimensioning. The dimensioning of the instant device is not concerned with "financial" or "aesthetic" considerations, but rather with functionality. In any event, Claim 10 again is merely a further limitation on Claim 1 and logically would appear to rise or fall with the fate of Claim 1 on which it depends.

Claim 11 which comprises a combination of Claim 1 and dependent Claims 2-10 was rejected over Edwards as a principal reference with Layton as a teaching reference. The same reasoning hereinbefore applied to the individual Claims 1-10 would be as is cumulatively applicable to Claim 11 and it is requested that the Examiner take note of this

fact to avoid duplicity in restating the same arguments.

The objections presented by the Examiner under 35 USC §103 all involve the concepts of combinational obviousness and it appears that the Examiner and the Applicants have differing views concerning the law relating to combinational obviousness. In view of this difference there is appended hereto Applicants' Memorandum setting forth the Applicants' views concerning combinational obviousness, as it appears here that the Examiner is making combinations of references where neither reference being combined indicates how or why both should be combined to anticipate the instant invention to accomplish the same results that the instant invention accomplishes. This appears to be what is commonly referred to as "a piecemeal picking of the prior art by way of hindsight", which is disapproved of by the CAFC, if not the PTO.

Conclusion

Prior art made of record and not relied upon is believed by Applicants to require no response and accordingly no response is made to that material. The references not relied upon are thought to be less relevant than those applied and discussed herein, but if the Examiner desires distinctions to be provided for those references Applicants will do so upon request.

Applicants believe that they have patentable subject matter expressed in the Claims in this application as amended and therefore have requested a re-consideration and further examination in light of this Amendment. Upon such reexamination it is urged that this matter be passed for allowance on the presently amended Claims.

Respectfully Submitted,
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COMBINATIONAL OBVIOUSNESS

Law Prior to CAFC

The Patent Office sought to resolve the combinational obviousness problem in McCullum case, 1914 CD 70, and the Supreme Court sought to resolve it in Graham v. John Deere, 338 US 1, 86 S. Ct. 684, 148 USPQ 459. Neither decision seems to have completely fulfilled this purpose, however.

Under these cases it was quite well settled law that a patentable inventive combination could not be anticipated by piecemeal finding of separate individual features of invention in the prior art, and especially in non-analogous prior art.

Rather it is necessary that all elements of an invention or their equivalents be found where they perform substantially the same function in substantially the same way.

Holstensson vs. Webcor. Inc., 112 USPQ 463

Anderson Co., vs. Sears, Roebuck & Co., 119 USPQ 236

Messing vs. Quiltmaster Corporation, 116 USPQ 378

Eversharp, Inc. vs. Fisherban Co., Inc., 132 USPQ 423

United Merchants & Manufacturers, Inc. vs. Ladd, 139 USPQ 199

Carboline Co., vs. Mobile Oil Corp., 163 USPQ 273

Bela Seating Co., vs. Poloron Products, Inc., 160 USPQ 646

Diversified Products Corp., vs. Sports Stores, Inc., 160 USPQ 458

Simmons Precision Products, Inc., vs. United States, 163 USPQ 465

The fact that all elements of a combination may be found in various patents does not of itself negate an invention. In re Hummer, 113 USPQ 66. A prior art reference cannot be used with hindsight to say, after the instant invention, that it would have been obvious to one of ordinary skill to have done what the inventor did, but rather the matter must be viewed at the time of the prior reference.

In re Ratti, 123 USPQ 349

Regent Jack Manufacturing Co., Inc. vs. United States, 130 USPQ 235

White vs. Tack Track, Inc., 140 USPQ 156

Ex parte Goonewardene vs. Love, 160 USPQ 287

References may not be combined when there is no suggestion in them that they could be combined to produce the results of the instant invention.

Tietig vs. Ladd, 141 USPQ 372

Matherson-Selling Co., vs. Carl Corr Color Card, Inc., 154 USPQ 265

Law Under CAFC

The Court of Appeals for the Federal Circuit (CAFC) since its formation in the fall of 1982 has followed the same general philosophy, though it undoubtedly has not completely filled its charge of increasing a doctrinal stability in the field of patent law. The test for a *prima facie* case of combinational obviousness has been stated to be whether there is something in the prior art as a whole to suggest the desirability and thus the obviousness of making a combination of elements found in a challenged claim of the present invention.

Custom Accessories v. Jeffrey Allen Industries, 897 F(2d) 955

Lindemann Maschinefabrik v. A.M. Hoist & Derrick, 221 USPQ 481

Fromson v. Advance Offset Plate, Inc., 225 USPQ 25

Grain Processing Corp. v. American Maize Products, 5 USPQ (2d) 1788

A variant of this test is whether the prior art would have suggested to one of ordinary skill that the invention should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art without reliance upon the present inventor's disclosure. In re Dow Chemical Co., 5 USPQ (2d) 1529.

In dealing with these basic obviousness rules, the CAFC has indicated that there must be at least a suggestion in the individual prior art references of the combination that is made in the instant invention. Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 USPQ (2d) 1434.

Both suggestion and expectation of success of making a combination must be found in the prior art itself and not in the Applicant's disclosure and that prior art must suggest the reason for the instant invention. In re Dow Chemical Co., 5 USPQ (2d) 1529. An invalidating suggestion from the prior art need not be an express indication. Milliken Research Corp. v. Dan River, Inc., 222 USPQ 571. Although the suggestion must be plain or clear.

Fromson v. Advance Offset Plate, Inc., *supra*;

King Instrument Corp. v. Otari Corp., 226 USPQ 402

Kimberly-Clark Corp. v. Johnson & Johnson, 223 USPQ 603

It is not sufficient to establish an invalidating suggestion to merely show some or all of the claim elements or limitations of the instant invention. The test is whether the prior art substantially shows the overall meaningful combination of the claim elements substantially as

opposed to merely cataloging those elements.

Interconnect Planning Corp., v. Feil, 227 USPQ 543

Custom Accessories v. Jeffrey-Allen Industries, 807 F (2d) 955

Lindemann Maschinefabrik v. Am. Hoist & Derrick, 221 USPQ 481

The suggestion or lack of it indicating advantages of the present invention is material in considering the prior art rather than merely focusing on structural elements. Even if there is only a slight structural difference, significant advantages over the prior art may result from the structural difference, significant advantages over the prior art may result from the structural difference and the failure of the prior art to suggest the advantage is an important factor in determining that there is no invalidating suggestion. Feil, 744, F(2d), 1143. There is, however, no requirement that there be advantages over the prior art as a prerequisite for no obviousness. Ryco. Inc. v. Ag-Bag Corp., 8 USPQ(2d) 1323.

Suggestions of purpose, function and problems solved by an invention have been held, where the prior art references have components of the instant invention, to be an important factor in deciding whether there is an invalidating suggestion. Lindemann Maschinefabrik v. Am. Hoist & Derrick, 730 F(2d), 1461-1462. The case of In re Wright, 6 USPQ (2d) 1959, reverses the Patent Office decision to the contrary in such a situation. The CAFC similarly has indicated that the similarity or dissimilarity of function between the instant invention and the prior art is an important consideration. Ryco. Inc. v. Ag-Bag Corp., 8 USPQ (2d) 1323; In re Fine, 5 USPQ (2d) 1596. The latter case again corrected the erroneous view of the Patent Office in this regard. In making these analyses, the CAFC indicated again in correcting Patent Office views, that the prior art must be looked at as a whole and each reference individually must be considered, as an invalidating suggestion cannot be found by construing individual statements in prior art references in a manner which is not supported by their context in the reference. In re Richard Wright, 9 USPQ(2d) 1649.

Those guidelines given by the CAFC concerning combinational obviousness are not complete and leave various areas of question. They do seem to resolve the problems in the instant matter, however, as in determining whether obviousness is shown by the prior art, one must look at that art as a whole rather than part by part. When that is done in this instance, it appears as hereinbefore stated that the prior art references of record are not concerned with the problems solved and do not recite the same structures or process as the instant invention. The Examiner makes an ingenuous and imaginative combination of the

prior art, but the skills involved are far beyond those of an ordinarily skilled designer in the field and the purposes are different, as the references do not have any showing as to how or why they should be combined with each other to accomplish either the structure, process, function or purpose of the instant invention.

MANUAL OF PATENT EXAMINING PROCEDURE, 3rd. Ed.
Change Notice

Reference: MPEP 706.03

SERIES NO. 18-1
(Follows Change 17-5)

July 23, 1968

REJECTIONS NOT BASED ON PRIOR ART

The primary object of the examination of an application is to determine whether or not the claims define a patentable advance over the prior art. This consideration should not be relegated to a secondary position while undue emphasis is given to non-prior art or "technical" rejections. Effort in examining should be concentrated on truly essential matters, minimizing or eliminating effort on matters which may have played a part in the examination process in the past but which are not really critical. Where a major technical rejection is proper (e.g., lack of proper disclosure, undue breadth, utility, etc.) such rejection should be stated with a full development of the reasons rather than by a mere conclusion coupled with some stereotyped expression.

Generally speaking, the inclusion of (1) negative limitations and (2) alternative expressions, provided that the alternatively expressed elements are basically equivalents for the purpose of the invention, are permitted if no uncertainty or ambiguity with respect to the question of scope or breadth of the claim is presented.

The examiner has the responsibility to make sure the wording of the claims is sufficiently definite to reasonably determine the scope. It is applicant's responsibility to select proper wording of the claim, except to the extent that the selection of words makes the claims indefinite. Under no circumstances should a claim be rejected merely because the Examiner prefers a different choice of wording.

Rejections not based on prior art are explained in 706.03 (a) to 706.03(y).
IF THE ITALICIZED LANGUAGE IN THESE SECTIONS IS INCORPORATED IN THE REJECTION, THERE WILL BE LESS CHANCE OF A MISUNDERSTANDING AS TO THE GROUNDS OF REJECTION.

Richard A. Wahl
Assistant Commissioner

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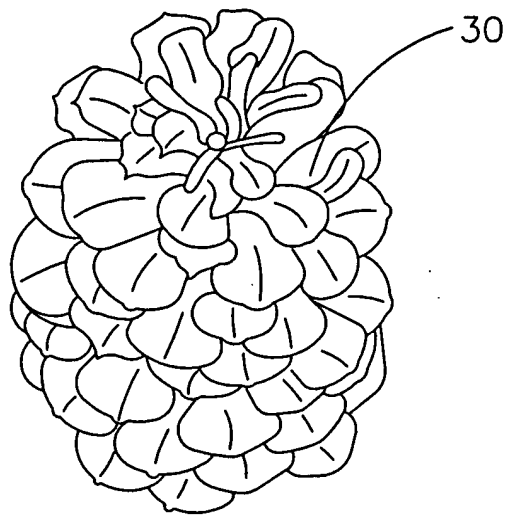


FIG. 9

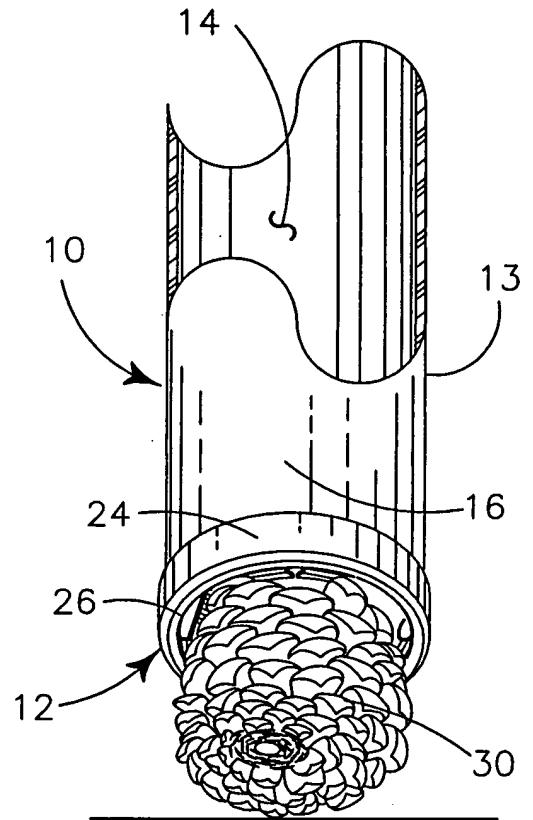


FIG. 1

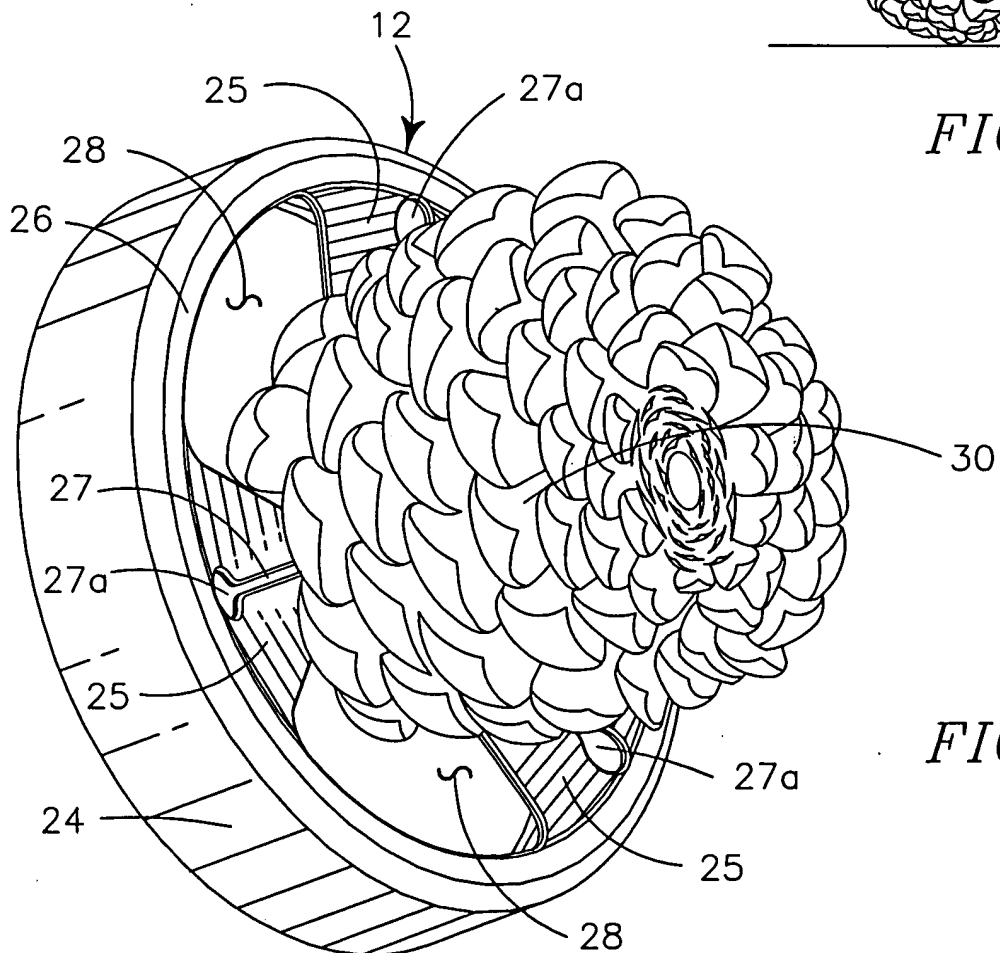


FIG. 1